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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 09/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,205

Applicant(s)

HUDSON ET AL.

Examiner

Chih-Min Kam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-12 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1,9-12 and 23 is/are allowed.
- 6) ☒ Claim(s) 6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The Request for Continued Examination (RCE) filed on July 11, 2003 (Paper No. 24) under 37 CFR 1.114 is acknowledged. An action on the RCE follows.

Status of the Claims

2. Claims 1, 6, 8-12 and 23 are pending.

Applicants' amendment after final rejection filed April 8, 2003 (Paper No. 22) has been entered, claims 6 and 8 have been amended, and claims 2-4 and 7 have been cancelled.

Applicants' amendment filed July 22, 2003 (Paper No. 25) and supplemental amendment filed August 21, 2003 (Paper No. 26) are acknowledged. Applicants' response has been fully considered. Claims 6 and 8 have been amended. Thus, claims 1, 6, 8-12 and 23 are examined.

Objection Withdrawn

3. The previous objection to the disclosure regarding embedded hyperlink and/or other form of browser-executable code is withdrawn in view of applicants' amendment to the specification, and applicants' response at page 2 in Paper No. 25.

Rejection Withdrawn

Claim Rejections - 35 USC § 102

4. The previous rejection of claim 6 under 35 U.S.C. 102(a) as being anticipated by NCI-Cancer Genome Anatomy Project (CGAP, EST, January 04, 1999), is withdrawn in view of applicants' amendment to the claim in Paper No. 26.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 6 and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 6 and 8 are directed to a fragment of SEQ ID NO:7 comprising nucleotide positions 6593-6595 of SEQ ID NO:7 and is at least 15 nucleotides; or a nucleic acid that hybridizes under stringency conditions to a nucleotide sequence comprising nucleotide positions 6593-6595 of SEQ ID NO:7 and is at least 10 flanking nucleotides of SEQ ID NO:7. The specification indicates that the invention includes fragments of the spastin gene, e.g., an isolated portion of a nucleotide sequence of SEQ ID NO:7 and the portion is at least 10 nucleotides in length (page 3, lines 8-12), and nucleic acid molecules can be identified to hybridize under stringent conditions to a nucleotide sequence of SEQ ID NO:7 (page 17, lines 11-16). However, the specification does not identify any fragment of SEQ ID NO:7 comprising nucleotide positions 6593-6595 of SEQ ID NO:7 and at least 15 nucleotides in length, or any nucleotide that hybridizes under stringency conditions to a fragment of SEQ ID NO:7 comprising nucleotide positions 6593-6595 of SEQ ID NO:7 and is at least 10 flanking nucleotides of SEQ ID NO:7. Without guidance on identities of the fragments of SEQ ID NO:7 containing nucleotide positions 6593-6595, and the correlation of structure to function/activity, one skilled in the art would not know how to use the fragments of SEQ ID NO:7. The lack of representative examples and teachings on the fragments of SEQ ID NO:7 containing nucleotide positions 6593-

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6595 as encompassed by the claims, applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise terms that a skilled artisan would not recognize applicants were in possession of the claimed invention.

In response, applicants indicate the specification discloses the nucleotide sequence of SEQ ID NO:7, its complement, fragments of SEQ ID NO:7 that are at least 10 nucleotides in length (page 3, lines 8-12), and nucleic acid molecules that hybridize under stringent conditions to a nucleotide sequence of SEQ ID NO:7 (page 17, line 11-page 18, line 11), since applicants were in possession of the complete nucleotide sequence of SEQ ID NO:7, thus they have been in possession of portions of SEQ ID NO:7; and the description of particular nucleotide sequence (e.g., SEQ ID NO:7 or its complement) to which the claimed sequence hybridizes and the description of hybridization conditions are sufficient identifying characteristics of the claimed sequences, thus they have been in possession of the claimed sequences (pages 2-4 of the response of Paper No. 25). The response has been fully considered, however, the argument is not found persuasive because the specification does not disclose the identity and function of any fragment of SEQ ID NO:7 containing nucleotide positions 6593-6595 of SEQ ID NO:7, nor demonstrates any nucleotide that hybridizes under stringency conditions to a fragment of SEQ ID NO:7 comprising nucleotide positions 6593-6595 of SEQ ID NO:7 as indicated above, thus, a skilled artisan would not recognize applicants were in possession of the claimed invention.

Conclusions

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6. Claims 6 and 8 are rejected, it appears claims 1, 9-12 and 23 are free of prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*
Patent Examiner

September 2, 2003

Christopher S. Low

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